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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,368	12/04/2001	Takayuki Iida	1982-0174P	9776
2292	7590	07/19/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, HUNG	
			ART UNIT	PAPER NUMBER
			2851	

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/000,368	<b>Applicant(s)</b> IIDA, TAKAYUKI	
	<b>Examiner</b> Hung Henry V Nguyen	<b>Art Unit</b> 2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 29-58 is/are pending in the application.
- 4a) Of the above claim(s) 31-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 29, 30 and 51-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7, 29, 30 and 51-58 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2004 has been entered.

### ***Election/Restrictions***

2. Applicant's request for withdrawal of claims 31-50 has been carefully considered. The traversal is on the ground(s) that each of the claimed inventions "require adding information to the visible image, and thus no serious burden is created". This is not found persuasive because firstly, whereas claims 1-7, 29, 30 is drawn to a print process method for carrying out print process and claims 31-50 are related to an image print order recording method wherein the order information is encoded. As such, the distinct and separate search are quite intensive and places a serious burden on the Examiner in regard to both examination and search. Secondly, whether the instant invention creates a burden or not is not germane to whether a restriction is proper. The issue here is whether the claims are independent and distinct, and the Examiner has demonstrated that they are.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5 and 7 are rejected under 35 U.S.C. 103(a) as being anticipated by Hicks (U.S.Pat. 5,359,387) in view of Shih et al (U.S.Pat. 6,674,923).

With respect to claims 3, 5 and 7, Hicks discloses a photographic process method for carrying out print process in which an image which corresponds to a visible image recorded on an image recording medium is formed, onto a new recording medium/final photographic print and the method comprising all of the limitations of the instant claims including steps of recording inputted order condition and process conditions as order information onto the image recording medium and forming image which is formed on the image recording medium onto a new image recording medium on the basis of the order information (see abstract and fig.2). Hicks does not expressly disclose the order information being electronically recorded onto the visible image recorded in the image recording medium. Shih et al teaches a method and system for producing the hard copy print where the order information (18) is electronically recorded onto the visible image recorded (16) in the image recording medium (see figure 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hicks and Shih to obtain the invention as specified in the instant claims. It would have been obvious to a skilled artisan to electronically record the order information as suggested by Shih onto the visible image recorded in the image recording medium

Art Unit: 2851

of Hicks. The purpose of doing so would have been to allow automatic processing of the order information and thus the processing time is greatly reduced.

4. Claims 1-7, 29-30, 51-58 are rejected under 35 U.S.C. 102 (e) as being anticipated by Slater et al (U.S.Pat. 6,157,435).

With respect to claims 1-7, 29-30, and 51-58, Slater et al discloses an photo finishing method for carrying out print processing in which an image which corresponds to a visible image (16) recorded on an image recording medium (12) is formed, onto a new image recording medium/ such as: photographic printing paper/a CD/PC card/computer...etc”, and comprising all basic steps as set forth in the instant claims such as: recording inputted order conditions and processing conditions/photo finishing instructions onto an image medium on which the visible image is formed (see figure 5) and forming the image which is formed on the image recording medium onto a photographic paper/new image medium based on the order information. Slater further teaches a scanner (40) for reading the image which is formed on the image recording medium and the monitor (305) for displaying the image which is formed on the image recording medium (see col.3, lines 45-50) and computer (302) for changing the displayed image by carrying out image processing on the basis of processing condition which are set in accordance with inputted order condition and a printer for forming the image recording medium onto a new image recording medium on the basis of the order information. Slater further teaches the processing condition including composite processing and index print/geometric processing and order condition including number of prints (see figure 5; col.16, lines 25-45) are electronically recorded on the new image recording medium.

Art Unit: 2851

***Response to Amendment***

5. Applicant's amendments filed April 29, 2004 have been entered. Applicant's arguments with respect to prior art have been carefully reviewed but have been traversed in view of new grounds of rejection as set forth above.

***Prior Art Made of Record***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Winter et al (U.S.Pat. 6,744,529) and Shiota (U.S.Pat. 6,169,596) discloses photo finishing system and have been cited for technical background.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Henry V Nguyen whose telephone number is 571-272-2124. The examiner can normally be reached on Monday-Friday (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 571-272-2112. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2851

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Hung Henry V Nguyen**  
**Primary Examiner**  
**Art Unit 2851**

hvn  
7/14/04